Docket No.: PMC-003C101
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John C. Harvey *et al.*

Application No.: 08/479,374 | Confirmation No.: 8137

Filed: June 7, 1995 | Art Unit: 2627

For: SIGNAL PROCESSING APPARATUS AND METHODS | Examiner: Jorge Ortiz-Criado

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER 37 CFR § 1.182

Pursuant to 37 C.F.R. § 1.182, the assignee of this application, Personalized Media Communications, LLC ("PMC" or "Applicant"), hereby petitions the United States Patent and Trademark Office ("PTO" or "Patent Office") for relief not otherwise provided for under the PTO rules. Specifically, Applicant hereby petitions the Director, under 37 C.F.R. § 1.182, to withdraw the recorded terminal disclaimer before the above-referenced patent application issues as a patent.

I. Standard for Requesting Withdrawal of a Terminal Disclaimer

MPEP § 1490 states that "if timely requested, a recorded terminal disclaimer may be withdrawn before the application in which it is filed issues as a patent." It further notes that because a terminal disclaimer does not take effect until after a patent is granted, and the public has not had the opportunity to rely on the terminal disclaimer, relief from the entry of a terminal disclaimer, which is no longer appropriate or proper, is properly available through a petition.

The filing and recordation of an unnecessary terminal disclaimer has been characterized as an "unhappy circumstance" in *In re Jentoft*, 392 F.2d 633, 157 USPQ 363 (CCPA 1968). Further, MPEP § 1490 states that "there is no statutory prohibition against nullifying or otherwise canceling the effect of a recorded terminal disclaimer which was erroneously filed before the patent issues." The PTO has held that the proper time—and indeed the only time—a terminal disclaimer may be withdrawn is prior to the issuance of a patent. *Decision Denying Petition, In re Reissue Application of Lee et al, Reissue Application No.* 09/933,918, March 21, 2005 ("*Lee Decision*").[1] As demonstrated below, the Terminal Disclaimer filed in this application is no longer appropriate and should be withdrawn.

II. Factual Background

The Terminal Disclaimer in the above-referenced application was filed October 21, 1998 pursuant to 37 C.F.R. § 1.321(c) and disclaimed, in essential terms, the terminal part of the statutory term of any patent granted on the above-referenced application, extending beyond the ***earliest expiration date*** of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on any of the then co-pending applications of the Applicant, i.e., ***the earliest expiration date*** for any patent which issued on any of the then co-pending applications.

This Terminal Disclaimer was filed in response to a Final Office Action mailed January 13, 1998, requiring Applicant to respond to the so-called "Administrative Requirement". This Requirement required the Applicant to either file a terminal disclaimer, to provide an affidavit attesting to the fact that no conflicting claims exist between co-pending applications, or to identify how all the claims in the instant application are separate and distinct from all the claims in the co-pending applications. At that time, Applicant chose to file the Terminal Disclaimer based on a clear understanding with the examiner handling this application that its filing would result in the issuance of a timely Notice of Allowance. No such Notice was then issued and

[1] The *Lee Decision* is a Final Decision from the Commissioner for Patents denying a petition to withdraw a terminal disclaimer via reissue because "petitioner knew, or should have known, [the withdrawal] had to be requested prior to issuance of the original patent". The *Lee Decision* further stated that "what is here controlling is that petitioner seeks to correct an issued patent", not a pending application as here.

further examination delays and suspensions have characterized the prosecution of this application for the last eleven years.

III. Basis for Request for Withdrawal

A. Statement of Changed Circumstances

Applicant respectfully requests withdrawal of the Terminal Disclaimer since more than eleven years have passed since its recordation and the claims in the above-referenced application have been amended at least four times, on April 13, 2000, March 13, 2002, March 6, 2003, and by an Examiner's Amendment the Applicant and Examiner agreed to incorporate on February 16, 2010. Specifically, in the course of prosecuting this application and its co-pending applications, the Applicant agreed to incorporate the claims from at least one other corresponding application (08/479,524) and expressly abandon that application. Moreover, as will be explained below, the claims pending in this application at the time that the Terminal Disclaimer was filed have been substantially amended, rendering any Terminal Disclaimer no longer appropriate for this application.

B. Comparison - Original Claims Subject to Disclaimer to Current Claims

The three (3) independent claims, which were presented in the application when the October 21, 1998 Terminal Disclaimer was filed, are set forth in the Appendix hereto for ease of comparison.

The seven (7) independent claims, currently presented in the application after the Examiner's Amendment agreed to by Applicants and the Examiner on February 16, 2009, are also identified in the Appendix hereto.

In Applicants' view, a simple comparison of these claim sets will demonstrate the merits of its current request.

C. Significant Claim Changes

Current independent claims 2, 6, and 7 are the only independent claims remaining from the group of original claims for which the Terminal Disclaimer was filed on October 21, 1998. Claims 2, 6, and 7, however, have been substantially amended to clarify and refine their scope.

Now, *e.g.*, claim 2 includes *at least* the additional limitations to (1) "storing at a memory operatively connected to said processor a computer program included in a first portion of said detected and passed digital data, wherein said computer program includes a program instruction set" and (2) to determining "a particular clear-and-continue address of instructions of said program instruction set, to jump to said address, and to execute clear-and continue instructions at said address, wherein under control of said clear-and-continue instructions said processor clears". Claim 6 includes *at least* the additional limitations of (1) "receiving a television signal including digital data including a computer program having a program instruction set," (2) "transmitting said television signal to said at least one of a plurality of receiver stations, said program instruction set effective to generate and communicate said television display to said television monitor at said at least one of a plurality of receiver stations" and (3) determining "a particular clear-and-continue address of instructions of said program instruction set, to jump to said address, and to execute clear-and-continue instructions at said address, wherein under control of said clear-and-continue instructions said processor clears". Claim 7 includes *at least* the additional limitations of (1) "receiving a television signal including digital data including a computer program having a program instruction set" and (2) "causing said television signal to be communicated to a transmitter, thereby to transmit said television signal to said at least one of a plurality of receiver stations, said program instruction set effective to generate and communicate said television display to said television monitor at said at least one of a plurality of receiver stations".

Additionally, current independent claims 8, 24, 28, and 31 were all incorporated into this application from another co-pending application after the filing of the Terminal Disclaimer and were not even present in the current application when the Terminal Disclaimer was filed. Also, many of the still co-pending applications have also since been suspended, amended, reexamined, allowed, withdrawn from allowance, appealed, and interviewed, thus further fundamentally altering the circumstances that necessitated the original filing of the Terminal Disclaimer over a decade ago.

Finally on February 18, 2010, in a telephone interview with Applicants' representative, Carl L. Benson, the Examiner stated that claims in their current were allowable over the art of record and that no other issue existed barring the issuance of the application as a patent. In Applicants' view, no question exists that the currently allowed claims of this application are

patentably distinct from Applicants' issued patents and all its co-pending and allowed applications. In fact, the Examiner has already informed Applicants that the Office has determined the allowed claims to be patentably distinct from the claims of Applicants' issued patents: U.S. Patents Nos. 4,694,490, 4,704,725, 4,965,825, 5,109,414, 5,233,654, 5,335,277 and 5,887,243. Thus, because the Examiner has indicated the current allowed claims of this application to be patentably distinct from U.S. Patent No. 5,887,243, the withdrawal of the Terminal Disclaimer would not be reopening the question of the propriety of any prior double patenting rejection and should be thus granted.

For all these reasons, Applicant respectfully requests withdrawal of the Terminal Disclaimer.

Please charge the petition fee in the amount of $400.00 to Deposit Account No. 50-4494. Please also charge any shortage in fees due in connection with the filing of this communication to Deposit Account No. 50-4494, and please credit any excess fees to such deposit account.

Dated: February 23, 2010

Respectfully submitted,

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APPENDIX

Original Claims

2. A method of generating a television display at a receiver station, said receiver station comprising a television monitor for displaying television programming and a processor for generating and communicating a video image to said television monitor, said method comprising the steps of:

receiving a television signal, said television signal including digital data;

detecting said digital data and passing said digital data to said processor;

generating and communicating said video image in response to said digital data;

inputting a clear-and-continue signal to said processor in response to said digital data detected in said television signal;

controlling said processor based on said clear-and-continue signal, said step of controlling comprising the steps of:

(a) clearing at least a portion of an output memory;

(b) jumping to a predetermined instruction; and

(c) generating video image information based on said predetermined instruction.

6. A method of generating a television display at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a television monitor for displaying television programming and a processor for generating and communicating a video image to said television monitor, comprising the steps of:

(a) receiving and storing a clear-and-continue signal;

(b) receiving a control signal which operates at a transmitter station to communicate said clear-and-continue signal to a transmitter;

(c) transmitting said clear-and-continue signal, said clear-and-continue signal effective at said at least one of a plurality of receiver stations to control said processor to clear at least a portion of an output memory, jump to a predetermined instruction, and generate video image information based on said predetermined instruction.

7. (Currently amended) A method of generating a television display at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a television monitor for displaying television programming and a processor for generating and communicating a video image to said television monitor, comprising the steps of:

(a) receiving and storing a clear-and-continue signal; and

(b) causing said clear-and-continue signal to be communicated to a transmitter at a specific time, thereby to transmit said clear-and-continue signal, said clear-and-continue signal effective at said at least one of a plurality of receiver stations to control said processor to clear at least a portion of an output memory, jump to a predetermined instruction, and generate video image information based on said predetermined instruction.

Current Claims

2. A method of generating a television display at a receiver station, said receiver station comprising a television monitor for displaying television programming and a processor for generating and communicating a video image to said television monitor, said method comprising the steps of:

receiving a television signal, said television signal including digital data;

detecting said digital data and passing said detected digital data to said processor;

storing at a memory operatively connected to said processor a computer program included in a first portion of said detected and passed digital data, wherein said computer program includes a program instruction set;

generating and communicating said video image to said television monitor in response to and based on said stored program instruction set;

inputting a clear-and-continue signal to said processor in response to a second portion of said detected and passed digital data; and

controlling said processor based on said clear-and-continue signal to determine a particular clear-and-continue address of instructions of said program instruction set, to jump to said address, and to execute clear-and continue instructions at said address, wherein under control of said clear-and-continue instructions said processor clears at least a portion of an output memory and generates and communicates video image information to said television monitor based on said clear-and-continue instructions.

6. A method of generating a television display at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a television monitor for displaying television programming and a processor for generating and communicating a video image to said television monitor, comprising the steps of:

(a) receiving a television signal including digital data including a computer program having a program instruction set;

(b) receiving a clear-and-continue signal;

(c) receiving a control signal which operates at a transmitter station to communicate said clear-and-continue signal to a transmitter;

(d) transmitting said television signal to said at least one of a plurality of receiver stations, said program instruction set effective to generate and communicate said

television display to said television monitor at said at least one of a plurality of receiver stations; and

(e) transmitting said clear-and-continue signal, said clear-and-continue signal effective at said at least one of a plurality of receiver stations to control said processor to determine a particular clear-and-continue address of instructions of said program instruction set, to jump to said address, and to execute clear-and-continue instructions at said address, wherein under control of said clear-and-continue instructions said processor clears at least a portion of an output memory, and generates and communicates video image information to said television monitor of said at least one of a plurality of receiver stations based on said clear-and-continue instructions.

7. A method of generating a television display at at least one of a plurality of receiver stations, each of said plurality of receiver stations having a television monitor for displaying television programming and a processor for generating and communicating a video image to said television monitor, comprising the steps of:

(a) receiving a television signal including digital data including a computer program having a program instruction set;

(b) receiving and storing a clear-and-continue signal;

(c) causing said television signal to be communicated to a transmitter, thereby to transmit said television signal to said at least one of a plurality of receiver stations, said program instruction set effective to generate and communicate said television display to said television monitor at said at least one of a plurality of receiver stations; and

(d) causing said clear-and-continue signal to be communicated to a transmitter at a specific time, thereby to transmit said clear-and-continue signal, said clear-and-continue signal effective at said at least one of a plurality of receiver stations to control said processor to determine a particular clear-and-continue address of instructions of said program instruction set, to jump to said address, and to execute clear-and-continue instructions at said address, wherein under control of said clear-and-continue instructions said processor clears at least a portion of an output memory, and generates and communicates video image information of said television display to said television monitor of said at least one of a plurality of receiver stations based on said clear-and-continue instructions.

8. A method of generating a television display in a receiver station, said receiver station including at least one processor for generating a television video image and a television monitor for displaying transmitted television programming and said television video image, said method comprising the steps of:

receiving a broadcast or cablecast transmission including said transmitted television programming and an information transmission, said information transmission further including a program instruction set;

detecting said information transmission in said broadcast or cablecast transmission;

passing said detected information transmission to said at least one processor;

causing said processor to execute said program instruction set;

receiving a clear-and-continue signal;

causing said at least one processor, in response to said clear-and-continue signal, to interrupt execution of said program instruction set, to store information regarding resumption of said program instruction set, and to jump to and execute clear-and-continue instructions in said program instruction set, said clear-and-continue instructions causing said at least one processor to clear a stored video image, to generate said television video image, to store said generated television image and to resume execution of said program instruction set in accordance with said stored information; and

displaying said generated television image with said transmitted television programming.

24. A method of generating a television display in at least one of a plurality of receiver stations, each of said plurality of receiver stations having a processor for generating a television video image and a television monitor for displaying transmitted television programming and said television video image, said method comprising the steps of:

transmitting from a transmitter station a television transmission including said television programming and an information transmission, said information transmission including a program instruction set for execution by said processor at said at least one of a plurality of receiver stations to control display of said transmitted television

programming and said television video image;

receiving, in ~~a~~ said transmitter station, a clear-and-continue signal;

receiving, in said transmitter station, a control signal which operates at said transmitter station to communicate said clear-and-continue signal to a transmitter; and

transmitting said clear-and-continue signal, said clear-and-continue signal effective in said at least one of said plurality of receiver stations to cause said processor to interrupt execution of said program instruction set, to store information regarding resumption of said program instruction set, and to jump to and execute clear-and-continue instructions in said program instruction set, said clear-and-continue instructions effective to cause said processor to clear a stored video image, to generate said television video image, to store said generated television video image and to resume execution of said program instruction set in accordance with sad stored information.

28. A method of generating a television display in at least one of a plurality of receiver stations, each of said plurality of receiver stations having a processor for generating a television video image and a television monitor for displaying transmitted television programming and said television video image, said method comprising the steps of:

transmitting from a transmitter station a television transmission including said television programming and an information transmission, said information transmission including a program instruction set for execution by said processor at said at least one of a plurality of receiver stations to control display of said transmitted television programming and said television video image;

receiving, in ~~a~~ said transmitter station, a clear-and-continue signal;

storing, in said transmitter station, said received clear-and-continue signal; and

causing said received and stored clear-and-continue signal to be communicated to a transmitter at a specific time, thereby to transmit said received and stored clear-and-continue signal, said received and stored instruct-to-clear signal effective in said at least one of said plurality of receiver stations to cause said processor to interrupt execution of said program instruction set, to store information regarding resumption of said program instruction set, and to jump to and execute clear-and-continue instructions in said program instruction set, said clear-and-continue instructions effective to cause said

processor to clear a stored video image, to generate said television video image, to store said generated television video image and to resume execution of said program instruction set in accordance with sad stored information.

31. A method of generating a television display in a receiver station, said receiver station including a processor for generating a viewer-specific television programming video image and a monitor for displaying said viewer-specific television programming video image, said method comprising the steps of:

receiving, from remote sources, (i) a broadcast or cablecast transmission including transmitted television programming and (ii) an information transmission including a program instruction set;

passing said information transmission and at least a portion of said transmitted television programming to said processor;

storing said passed information transmission;

causing said processor to execute said program instruction set;

receiving a clear-and-continue signal;

causing said processor, in response to said clear-and-continue signal, to interrupt execution of said program instruction set, to store information regarding resumption of said program instruction set, and to jump to and execute clear-and-continue instructions in said program instruction set, said clear-and-continue instructions causing said processor to clear a memory to generate a viewer-specific television video image for storage at said memory and to resume execution of said program instruction set in accordance with said stored information; and

combining said viewer-specific television video image and said transmitted television programming to.